

REMARKS/ARGUMENTS

Upon entry of the above amendment, claim 27 will have been amended and submitted for consideration by the Examiner. Thus, claims 24-30 are pending for consideration by the Examiner. In view of the above, Applicants respectfully request reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided, and for re-sending the initialed and signed PTO-1449 Forms on which the filing dates of June 13, 2000, January 8, 2001 and October 22, 2002 are indicated by mailroom date-stamps.

However, Applicants have also filed an Information Disclosure Statement in the present application on September 17, 1999. Thus, Applicants respectfully request that the Examiner consider the documents cited in the Information Disclosure Statement of September 17, 1999.

Turning to the merits of the action, the Examiner has rejected claims 24-30 under 35 U.S.C § 102(e) as being anticipated by FEDER (U.S. Patent 5,872,840).

As noted above, claims 24-30 remain pending. Applicants respectfully traverse the above rejections based on pending claims 24-30 and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicants' claims 24-26 relate to a server apparatus connected with a transmitting facsimile and a receiving facsimile via the Internet. The server apparatus stores capabilities regarding facsimile data that the receiving facsimile can receive. The server apparatus receives facsimile data from the transmitting facsimile, transforms the received facsimile data into a type of facsimile data that the receiving facsimile can receive, based on the stored capabilities of the receiving facsimile, and transmits the transformed facsimile data to the receiving facsimile. Claim 30 recites a related method.

On the contrary, FEDER discloses fax transmission over a packet-switched digital communication network. Fig. 1 of FEDER describes that when the first machine 110 transmits a fax message to the second fax machine 170 using digital communication, the first interface apparatus 120 intercepts the fax message, enhances its data compression, and transmits it as an image data file using a data modem. The message is sent from the first interface apparatus 120 to a local server 130. The local server receives the message, encapsulates it within a data file, and forwards it to network 140 which delivers the message to the remote server 150. Fig. 1 of FEDER also teaches that upon receiving the message from the network, the remote server 150 de-encapsulates the image data file and transmits it to the second interface apparatus 160, which converts the image data file to a conventional fax message format and transmits it to a second fax machine 170. Further, Fig. 2A of FEDER describes components of the first interface apparatus 120.

In the outstanding Official Action, the Examiner makes reference to column 10, lines 33- 44 of FEDER and asserts that it teaches that "The service, in general, has a

capability to determine, on the basis of the data stored therein, the capability of the intended recipient of the file and, according to the determined capability of the recipient, send the file in a suitable format.” Applicants traverse and submit that the Examiner is misinterpreting this portion of FEDER disclosure. To clarify the meaning of the above sentence, Applicants would like to put the sentence in its proper context.

In column 10, lines 4-25, FEDER discloses that when the destination fax machine 570 does not have the interface installed therein, the remote server 550 associated with the destination fax machine 570 is utilized. The remote server 550 receives a message from a network 140, decompresses the message, and converts it to raw data. The remote server 550 re-encodes the data, dials the destination fax machine 570, and transmits the re-encoded data to the destination fax machine 570.

At col. 10, lines 26-32, FEDER discloses that when the remote server 550 receives the message, the remote server 550 re-encodes the message in several formats and “stores in memory data files created for each such format.” In this case, when the destination fax machine 570 transmits the DIS to the remote server 570, the remote server 550 transmits an appropriate format to the destination fax machine 570 and erases the others stored in the memory.

At column 10, lines 33-44, FEDER discloses that the service maintains a registry of fax machines that have installed the interface of the invention. The interface may register such fax machines automatically once the interface has been properly coupled to the fax machine. The remote server computer “stores this information.”

Now, Applicants consider the meaning of “on the basis of the data stored therein” of column 10, lines 41- 42 noted by the Examiner. As noted above, what is stored in the memory of the remote server 550, can be “data files created for each such format” or “this information” regarding fax machines that have installed the interface.

Thus, “The service, in general, has a capability to determine, on the basis of the data stored therein, the capability of the intended recipient of the file and, according to the determined capability of the recipient, send the file in a suitable format.” (column 10, lines 33- 44 of FEDER) means that the service, in general, has a capability to determine, on the basis of the data file created for the appropriate format or the information regarding fax machines that have the interface installed therein, the capability of the intended recipient of the file and, according to the determined capability of the recipient, send the file in a suitable format.

However, in the case of the former, since the remote server 550 erases the files in other than the appropriate format, the remote server 550 merely stores a “data file” created for the appropriate format, e.g. MH format. However, the “data file” created for the appropriate format does not contain information regarding a format appropriate for a recipient, e.g., MH itself. Although the server apparatus might be able to determine the capability of the intended recipient of the file based on the data file created for the appropriate format, the server apparatus cannot transform the received facsimile data into a type of facsimile data that the receiving facsimile can receive based on the data file created for the appropriate format. Thus, the data file created for the appropriate format is

not “capabilities regarding facsimile data that the receiving facsimile can receive”, as recited in claim 24 of the pending application. In direct contrast to the recitations of claim 24, the capabilities of the receiving fax in FEDER are determined based on the DIS (column 1, lines 54-58), but are not stored in a memory, as recited herein.

Additionally, Applicants' claim 24 calls for transforming received data based on the capabilities stored. This is clearly not true for FEDER since the appropriate format is sent based on DIS, but not based on stored “capabilities”.

In the case of the latter (i.e., information regarding fax machines), the remote server 550 stores the information regarding fax machines that have the interface installed therein. However, the stored information does not comprise “capabilities regarding facsimile data that the receiving facsimile can receive”, since the server apparatus cannot transform the received facsimile data into a type of facsimile data that the receiving facsimile can receive, based on whether the called fax machine has the interface installed.

Therefore, claim 24 of the pending claim is clearly distinguished from FEDER, since the memory of FEDER stores the data file created for the appropriate format or the information regarding fax machines that have the interface installed, but does not store “capabilities” as recited in claim 24.

Further, although Fig. 2 of FEDER discloses a memory 245, the memory 245 merely stores telephone numbers (column 9, lines 27-32). However, telephone numbers are not “capabilities regarding facsimile data that the receiving facsimile can receive”, since the server apparatus can not transform the received facsimile data into a type of

facsimile data that the receiving facsimile can receive, based on the telephone number of the receiving apparatus. Thus, claim 24 of the pending claim is further distinguished from FEDER, since FEDER does not store capabilities regarding facsimile data that the receiving facsimile can receive.

Further, column 9, lines 53-57 teaches that information relating to the calling and called stations, and data related to the message being transmitted are stored in the memory of the interface 160. However, information relating to the calling and called stations are not “capabilities regarding facsimile data that the receiving facsimile can receive”, for the same reason set forth above regarding telephone numbers. The data related to the message being transmitted is not “capabilities regarding facsimile data that the receiving facsimile can receive”, since the data is the received facsimile data itself. Thus, claim 24 of the pending claim is additionally distinguished from FEDER, since FEDER does not store capabilities regarding facsimile data that the receiving facsimile can receive.

Therefore, it is respectfully submitted that the features recited in Applicants’ claims 24-26 and 30 are not taught in FEDER cited by the Examiner.

Applicants claims 27-29 relate to a server apparatus and an Internet facsimile that transmit and receive an e-mail with a predetermined address. The e-mail with the predetermined address indicates the capabilities of the Internet facsimile apparatus to be stored in the memory of the server apparatus.

However, column 8 lines 37-68 of FEDER cited by the Examiner merely gives
general explanations for transmitting a fax message in a standard e-mail format. The

present application provides similar explanations on page 14, lines 3-15 of the specification, but these are not the features of claims 27-29. The features of claims 27-29 are disclosed on e.g., page 15, lines 14-27 and page 16, lines 1-18 of the specification of the present application. Thus, column 8 lines 37-68 of FEDER has no relation to the features of claims 27-29.

Therefore, it is respectfully submitted that the features recited in Applicants' claims 27-29 are also not rendered obvious in FEDER cited by the Examiner.

Accordingly, for each of these reasons, and certainly for all of these reasons, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection and an indication of the allowability of all the claims pending in the present application in due course.

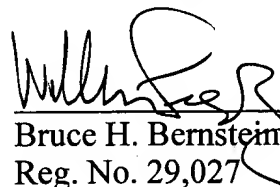
SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have resubmitted the claims for consideration by the Examiner. With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the submitted claims with the disclosures of the cited reference. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Yoshihiro IDA et al.

 RN 933630
Bruce H. Bernstein
Reg. No. 29,027

April 14, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191